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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/894,042	06/28/2001	Dane R. Jackson	460.2125USU	5504
7590	01/28/2004			
Charles N.J. Ruggiero, Esq. Ohlandt, Greeley, Ruggiero & Perle, L.L.P. One Landmark Square, 10th Floor Stamford, CT 06901-2682			EXAMINER KIDWELL, MICHELE M	
			ART UNIT 3761	PAPER NUMBER 15
DATE MAILED: 01/28/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/894,042

Applicant(s)

JACKSON ET AL.

Examiner

Michele Kidwell

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3761

-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7-23 and 25-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 25-28 is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4, 5, 7, 9-14, 16-20, 22 and 23 is/are rejected.
- 7) ☒ Claim(s) 3, 8, 15 and 21 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 16.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 4 – 5, 7, 9 – 14, 16 – 20 and 22 – 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Lichstein (US 4,536,178).

With respect to claims 1 – 2, 7 and 9 – 12, Lichstein discloses a barrel (16) that has a fingergrip area (32). The plunger is 18. The fingergrip area has two flattened surfaces (30). The gripping structure is considered to be embossments (36). The treaded structures (col. 4, lines 17 – 19) are raised above flat surface (30); therefore, they satisfy the Markush member of embossments. Embossments (36) tilt away from the flat surface. Lichstein discloses a rectangular cross section shape to the same extent that the instant application discloses a rectangular cross sectional shape.

With respect to claims 4 and 5, the two angled surfaces (34) are shown in figure 1.

With respect to claims 13 – 14 and 16 – 18, Lichstein discloses a barrel (16) with a gripping area (32). The gripping area has two convex surfaces that are the portions of 32 that are convex (between the flat surfaces 30). The treaded gripping structure (col. 4, lines 17 – 19) satisfies the Markush member of embossments. The angled shoulder

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surfaces are 34. The form a shoulder and are angled. The convex surfaces of Lichstein are fully capable of being gripped.

With respect to claims 19 – 20 and 22 – 23, Lichstein discloses a barrel (16) with a gripping area (32). The gripping area has two concave surfaces that are considered to be the depressions that are disclosed in col. 4, lines 14 – 24. The gripping structure is considered to be embossments (36). The treaded structures (col. 4, lines 17 – 19) are raised above flat surface (30); therefore, they satisfy the Markush member of embossments. The angled shoulder surfaces are 34. The form a shoulder and are angled.

#### ***Allowable Subject Matter***

Claims 3, 8, 15 and 21 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 25 – 28 are allowed.

#### ***Response to Arguments***

Applicant's arguments filed July 30, 2003 have been fully considered but they are not persuasive.

Initially, the examiner refers to 37 CFR 1.98(b):

**37 CFR 1.98(b)** requires that each item of information in an IDS be identified properly. U.S. patents must be identified by the inventor, patent number, and issue date. U.S. patent application publications must be identified by the applicant, patent application publication number, and publication date. U.S. applications must be identified by the inventor, the eight digit application number (the two digit series code and the six digit serial number), and the filing date. If a U.S. application being listed in

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an IDS has been issued as a patent, the applicant should list the patent in the IDS instead of the application. Each foreign patent or published foreign patent application must be identified by the country or patent office which issued the patent or published the application, an appropriate document number, and the publication date indicated on the patent or published application. Each publication must be identified by publisher, author (if any), title, relevant pages of the publication, and date and place of publication. The date of publication supplied must include at least the month and year of publication, except that the year of publication (without the month) will be accepted if the applicant points out in the information disclosure statement that the year of publication is sufficiently earlier than the effective U.S. filing date and any foreign priority date so that the particular month of publication is not in issue. The place of publication refers to the name of the journal, magazine, or other publication in which the information being submitted was published.

The information related to the pending litigation involving U.S. Patent No. 4,536,178 has not been considered because the submission fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because each item of information has not been properly identified. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 ¶ C(1).

With respect to the applicant's arguments that Lichstein fails to disclose a tampon applicator having at least one substantially flattened surface with at least one gripping structure selected from the group recited in claim 1, the examiner disagrees.

Lichstein discloses a tampon applicator having at least one substantially flattened surface with at least one gripping structure in the form of a tread as set forth in col. 4,

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lines 17 – 19. A tread is an embossment other than those listed in the Markush grouping of claim one, thereby meeting the claimed limitations.

With respect to the applicant's argument that Lichstein fails to disclose any gripping structure that is aligned with the at least one substantially flattened surface, the examiner disagrees.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., an embossment which does not extend above the substantially flattened surface) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In order for the gripping structure to be aligned with the outer surface of the substantially flattened surface, the gripping structure is only required to fall into line with or be in line with the outer surface of the substantially flattened surface, both of which are shown by Lichstein in figure 1.

With respect to the applicant's argument that Lichstein fails to disclose or suggest a finger grip area having at least one convex gripping surface with at least one gripping structure, the examiner contends that the applicant's arguments are not commensurate with the claim language.

The applicant argues that rear portions (32) of Lichstein do not have one or more gripping structures, however, the claim language does not require the rear

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portions to have a gripping structure. The claim recites a fingergrasp area having at least one convex gripping surface with at least one gripping structure. This language does not require the gripping structure to be formed on the gripping surface as argued by the applicant. This claim language requires a fingergrasp area having (1) at least one convex gripping structure and (2) at least one gripping structure, both of which have been disclosed by Lichstein as set forth in the rejection of claim 13 and in figure 1.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**.

See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michele Kidwell whose telephone number is


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703-305-2941. The examiner can normally be reached on Monday - Friday,  
7:30am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo can be reached on 703-308-1957. The fax phone number for the organization where this application or proceeding is assigned is 703-305-3590.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

  
Michele Kidwell  
January 24, 2004

  
GLENN K. DAWSON  
PRIMARY EXAMINER